REMARKS

Claims 1-12 are pending in this application, with claims 9-12 original as filed. After a first-issued Final Office Action, Applicants filed an Appeal with the Board of Patent and Trademark Appeals arguing that the claims were patentable over cited prior art references Pogue and Appleman. The Examiner was persuaded by these arguments, has conducted a new prior art search, and has reopened prosecution.

Claims 1-8 are now considered allowable over the prior art, but are rejected under the nonstatutory obviousness-type double patenting.

Claims 9-12 now stand rejected under 35 U.S.C. §103(a) as being unpatentable over the previously-cited reference Pogue (U.S. Patent No. 6,112,240) in view of newly cited prior art, U.S. Patent No. 6,073,138 (l'Etraz et al.).

As the claims are thought to be distinguishable over the prior art presented, no amendments to the claims are deemed necessary. Applicants respectfully request reconsideration and allowance of all claims in view of the remarks presented below.


A. *Removal Of The Finality Of The Rejection Is Proper*

Further to the telephonic interview conducted with the Examiner on August 16, 2006, Applicants respectfully request that the finality of the Office Action be withdrawn. The Examiner has submitted a new reference (l'Etraz et al.) and argued new grounds of rejection for claims 9-12. The new grounds of rejection were not necessitated by an amendment, as claims 9-12 have not been previously amended. Accordingly, Applicants submit that the finality of the instant Office Action is premature under MPEP 706.07(a), and request that the finality of the instant Office Action be withdrawn under MPEP 706.07(d).

MPEP 706.07(a) states that a second or subsequent action on the merits in any application will NOT be made final if it includes a rejection on NEWLY CITED PRIOR ART of any claim NOT AMENDED "in spite of the fact that other claims may have been amended to require newly cited art."

In the present case, claim 1 (and thus dependent claims 2-8) was amended in Applicants' first response to Office Action but claims 9-12 were original as filed and never amended. Since not all claims were amended, introduction of the newly cited l'Etraz prior art as new grounds for rejection should not result in a Final Office Action against unamended claims. Removal of the finality of the rejection is thus proper under MPEP 706.07(d).

## B. *Issuance Of An Obviousness-Type Double Patenting Rejection Is Improper In An Earlier-Filed Application*

Claims 1-12 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over similar claims 1-9 of co-pending Application No. 10/086,036 (Our Docket No. 3561-131 "Traffic Sampling"). Although this rejection can be overcome by the filing of a Terminal Disclaimer, none is considered necessary in this case since the present application pre-dates the '10/086,036 application. As stated in the Manual of Examining Procedure:

> If a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.
> MPEP 804(I)(B)(1)

As the '036 application is currently rejected under other grounds, removal of the obviousness-type double patenting rejection is proper. Furthermore, the current application was filed (Nov. 2, 2001) prior to the '036 application (February 27, 2002) and thus any terminal disclaimer would not act to limit the term of the current application. Accordingly, any need for a terminal disclaimer would be moot.

## C. *The Prior Art Fails To Teach Key Elements Of Claims 9-12*

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pogue et al. (U.S. Patent No. 6,112,240) and de l'Etraz et al. (U.S. Patent No. 6,073,138).

### a. *l'Etraz Data Mining Operates Via Manual Entry At The Client Node And Thus Is Not Operable On The Client Node To Return Data Based On The Operation Steps*

Claims 9-12 have been rejected as being unpatentable over U.S. Patent No. 6,112,240 to Pogue, et al. and U.S. Patent No. 6,073,138 to de l'Etraz. The Examiner has substituted the l'Etraz patent for the Appleman patent cited in previous actions, pointing to the explicit use of data mining tools within l'Etraz. The l'Etraz data mining tool is not "embedded within a web page" as required under claims 9-12. Instead, and in the words of the l'Etraz patent itself, the data mining tool is a "stand-alone application program" (Col. 5, lines 30-31) that "allows a user (e.g., business person) to enter and store their private contact information"
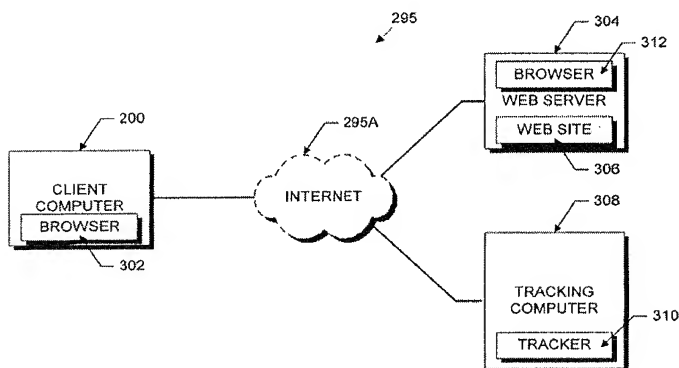
(Col. 5, lines 33-34) and "also have access to a database containing publicly available information concerning multi-national corporation boards of directors." (Col. 5, lines 35-37)

Even if such a data mining tool were available through a World-Wide Web site as proposed in l'Etraz, Col. 6, line 3, the web page described simply provides a manual data entry field on the client node and allows queries on a server remote from the client node. In other words, l'Etraz would not result in the claim 9 steps of (a) "operating the data mining script on the client node" and then, because l'Etraz requires manual entry of data by the client rather than retrieval by a data mining script, would also not result in (b) "returning data resulting from the operation steps."

### b. Pogue Does Not Teach The Concept Of Embedding Cookie Processing Scripts Within The Transmitted Web Page And Operating The Cookie Processing Script On The Client Computer

The Pogue reference does not teach the concept of embedding cookie processing scripts within the transmitted web page and operating the cookie processing script on the client computer. Furthermore, any new cookie generated by the script (claim 10) is generated in the Pogue tracker 310 rather than on the client node as required in claim 10. The following arguments were made in the Appeal and the Examiner has appeared to accept them.

The current rejections hinge on the finding by the Examiner that the Pogue reference teaches the steps for (a) embedding cookie processing script in the web page code and (b) operating the cookie processing script on the web browsing data to obtain new cookie values. The Examiner cites the material in Pogue FIG. 6, and the text starting at Col. 6, line 46 through Col. 7, line 22 for support of this interpretation. Appellants traverse this reasoning on the grounds that Pogue does not teach the concept of embedding cookie processing scripts within the transmitted web page and operating the cookie processing script on the client computer. Instead, Pogue appears to teach that all cookies are generated in a tracker 310 external to the client computer 200.



Pogue (Figure 3 to the left) clearly identifies the physical difference between a client computer 200 (which host the browser 302) and the tracking computer 308 (which hosts the tracker

310) connected through the Internet cloud 295A.

Then Pogue (Col. 6, line 51 to Col. 7, line 10) describes Step 602 where "the browser 302 then reads and executes the tracker tag, which causes a tracker message to be directed from the browser 302 to the tracker 310 <u>on the tracking computer 308</u>." (emphasis added)

Clearly at this stage, there is a physical difference between the client computer 200 and the tracking computer 308. But to further the point, Pogue clearly admits that cookie processing is accomplished on the tracking computer 308 by the comment (Col. 7, lines 11-15) that "the tracker 310 then transmits a new cookie to the browser 302...."

In addition, Pogue (Col. 7, lines 48-50) further identifies that a tracker 310 is "any program that implements the above described processes. In the preferred embodiment, the tracker 310 is a <u>CGI program</u> written in C++." This statement, for someone skilled in the arts, clearly limits the applicability of program execution for the tracker 310 program, as web browser 302 does not support the concept of a CGI gateway.

More specifically, Pogue states only generally that "the tracker 310 uses cookies and common gateway (CGI) scripts to obtain the client information." The tracker 310, however, operates on the tracking computer 308 and <u>not</u> on the browser of the client computer 200, see, *e.g.*, Pogue FIG. 3. Furthermore, FIG. 6 shows that the tracker directs the cookie to the browser; a step that would be unnecessary in the present invention where the cookie is generated at the client computer itself by the cookie generating script residing there. Responsive to a browser command at the client computer, the Pogue tracker (external of the client computer) receives the last cookie [Col. 7, line 3] and then transmits a new cookie to the browser [Col. 7, lines 11-13] thereby replacing the old cookie.

In summary, therefore, Pogue does not in fact teach the steps of embedding cookie processing script within the web page and sending the web page (and the script) to the visitor computer to operate thereon. Instead, Pogue appears to teach common usage of cookies that are stored on the visitor computer, accessed during a web page download request, and changed at the web page server or associated external computer to indicate the request. Such a feature would be blocked by the browser feature noted in the Background of the Invention section, see, *e.g.*, page 3, lines 7-15 of the filed application. In claim 9, the wording explicitly states that the cookie processing script is operated at the client node. None of the prior art of record provide the missing elements from the claims and therefore rejection under §103(a) would be improper. Furthermore, as the claims dependent from independent claim 9 necessarily include such a feature, missing from the prior art, such dependent claims would be likewise allowable over the prior art of record.

Despite the clear indication within Pogue that the cookie processing script is operated externally to the visitor computer or client node, the Examiner has addressed the above distinguishing remarks in an earlier Office Action as follows:

> The applicant argued in substance that Pogue does not teach the concept of embedding cookie processing scripts within the transmitted web page and operating the cookie processing script on the client computer. The examiner points to Col. 7, lines 11-47, wherein Pogue describes sending a cookie to the browser 302 then a few steps later, "This causes the browser 302 to execute the applet on the client computer 200, thereby gathering the client information." The tracker tag is written in Javascript and runs on the client computer, *See,* Col. 4, line 61- Col. 5, line 4.
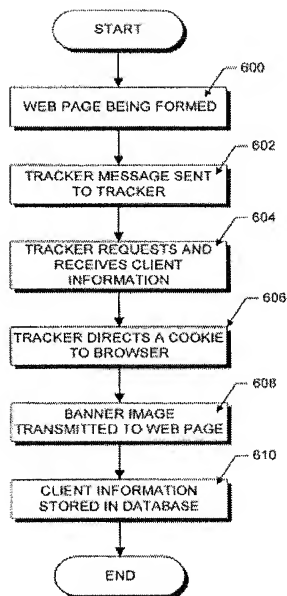
The Examiner appears to be confusing two distinct implementations of the web site information tracker noted in the Pogue reference. In one, shown in FIG. 6 (to the left), a tracker operates remotely from the visitor computer and transmits new cookies to the visitor computer to replace old ones. The new cookie is generated at the tracker 310 responsive to information received from the visitor computer together with the old cookie. The alternate embodiment of the tracking system is shown in FIG. 7 (to the right) and comprises a "tracker tab" Java applet that gathers client
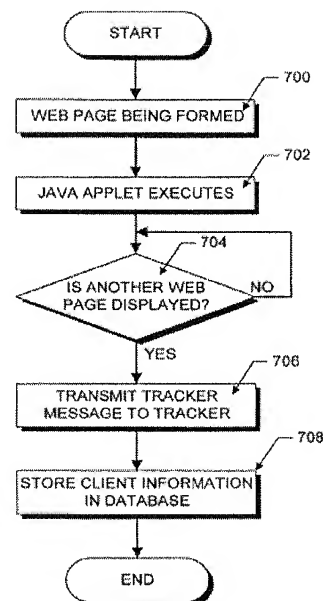


*FIG. 6*



*FIG. 7*

information and transmits this information back to the remote tracker 310 via a tracker message. Combination of these two distinct embodiments is impermissible and there is no indication that such would work. (See, e.g., Section C below) Even if FIG. 6 and FIG. 7 could be combined, there is no indication in the FIG. 7 tracker tag Java applet that acts as a "cookie processing script." In other words, the Java applet in Pogue does not process a cookie value based on tracked events to obtain a "new cookie value", and "write the new cookie value to the client node" as specified in claim 10.

It appears from the quote above that the Examiner has made the "tracker tag" of the Pogue embodiment of FIG. 7 an equivalent to the "cookie processing script" in the present invention. Case law is fairly specific on how claim language is to be interpreted during prosecution. "Words in a claim are generally given their ordinary and accustomed meaning unless the inventor chooses to be his own lexicographer in the specification." *Lantech, Inc. v.*

*Keip Mach. Co.*, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). "In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification." *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The Federal Circuit cautions, however, that the PTO is not to erroneously construe the claims (as was the case in *Baker Hughes*) where such construction was "beyond that which was reasonable in light of the totality of the written description." *In re Baker Hughes, Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000).
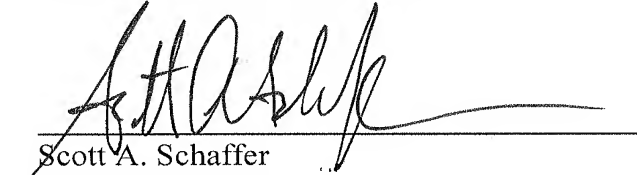
The fact that the tracker tag is written in the same computer language (Javascript) as a preferred embodiment of the cookie processing script is not definitive. The pending patent application on appeal in fact includes two elements downloaded with the web page to and operable on the visitor computer: data mining script, and cookie processing script. The Pogue tracker tag is one element, not two. Additionally, and more importantly, the Pogue tracker tag does not perform critical functions that characterize the very definition of cookie processing script: a cookie processing function that results in a modified cookie being written to the client node. Appellants suggest, therefore, that the Examiner is associating an unreasonably broad meaning to the "cookie processing script" limitation in the pending claims in violation of case law under *Baker Hughes* and related cases. Appellants thus respectfully submit that the claims as written be allowable over the Pogue reference and combinations therewith.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-12 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Scott A. Schaffer
Reg. No. 38,610

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
**Customer No. 20575**